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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/270,241 03/15/99 KATZ R 228/022

EXAMINER

LM02/0720

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47TH FLOOR
LOS ANGELES CA 90071

ART UNIT	PAPER NUMBER
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2743

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DATE MAILED:

07/20/99

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

669144 44022611

Office Action Summary

Application No.

09/270,241

Applicant(s)

Katz

Examiner

Stella Woo

Group Art Unit

2743



☐ Responsive to communication(s) filed on _____

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) 29-38 is/are pending in the application.

Of the above, claim(s) _____ is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) 29-38 is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☒ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☒ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been

☐ received.

☐ received in Application No. (Series Code/Serial Number) _____

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☒ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

☐ Interview Summary, PTO-413

☒ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

Art Unit: 2743

DETAILED ACTION

1. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

2. Claims 29-38 are rejected under the judicially created doctrine of double patenting over claims 11, 14 and 25 of U. S. Patent No. 4,845,739 since the claims, if allowed, would improperly extend the "right to exclude" already granted in the patent.

The subject matter claimed in the instant application is fully disclosed in the patent and is covered by the patent since the patent and the application are claiming common subject matter.

The subject matter recited in claims 29-40 of the present application is fully disclosed in the patent. The allowance of these claims would extend the rights to exclude already granted in claims 11, 14 and 25 of the patent. The transitional phrase "comprising" does not exclude the presence of elements other those recited in claims 11, 14 and 25 of the patent. Because of the phrase "comprising" the patent claim not only provides protection to the combination of elements recited but also extends patent coverage to the disclosed combination of elements recited in claims 29-38 of the present application. Thus, the controlling fact is that patent protection for the

Art Unit: 2743

device, fully disclosed in and covered by the claims of the patent, would be extended by the allowance of the claims in the application.

Furthermore, there is no apparent reason why applicant was prevented from presenting claims corresponding to those of the instant application during prosecution of the application which matured into a patent. *In re Schneller*, 397 F.2d 350, 158 USPQ 210 (CCPA 1968). See also MPEP § 804.

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 29-30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gordon et al. (Gordon) in view of Riskin.

Gordon discloses a control system for use with a communication facility (telephone network) including remote terminals (telephone state sets 11), said control system comprising:

a processor unit (processor 205);

interface structure (col. 8, lines 56-68) which receives called number data signals ("800" dial-a-view number) and calling number identification data (ANI number);

means for controlling said processor unit (col. 8, lines 10-38).

Gordon differs from claim 29 in that the caller is prompted for caller qualification data (credit card number entered via telephone set; col. 2, line 65 - col. 3, line 3) by vendor personnel

Art Unit: 2743

(col. 10, lines 35-38) rather than a voice generator. However, Riskin teaches the desirability of using a voice generator for prompting caller input as an alternative to a human operator (col. 2, lines 61-66) such that it would have been obvious to an artisan of ordinary skill to replace the human operator of Gordon with a voice generator, as taught by Riskin.

Regarding DNIS, since this feature is enclosed in parentheses, it is interpreted as an option rather than an actual claim limitation. However, should the claim be amended to require the use of DNIS, Riskin teaches that with ISDN, it is well known to use DNIS for passing along the originally dialed 800 number such that it would have been obvious to an artisan of ordinary skill to incorporate the use of DNIS, as taught by Riskin, for passing along the dialed 800 number of Gordon.

5. Claims 31-38 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gordon in view of Troy et al. (Troy) for the same reasons given in the last Office action and repeated below.

Gordon discloses a system comprising:

interface structure (col. 5, line 67 - col. 6, line 5; col. 6, lines 38-51; col. 7, lines 2-48; col. 8, line 59 - col. 9, line 7; col. 9, lines 47-60);
record testing structure (col. 8, lines 3-23);
analysis structure (col. 8, lines 25-38).

Gordon differs from claim 31 in that it does not specify receiving a caller's social security. However, as taught by Troy (col. 4, lines 54-60), it is well known in the art to use social security numbers for user identification such that it would have been obvious to an artisan of ordinary skill

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Art Unit: 2743

to incorporate the use of social security numbers, as taught by Troy, within the system of Gordon for further identifying the caller.

Regarding claims 32-34, 36-38, note Gordon, col. 10, lines 35-38.

Regarding claim 35, Gordon provides for storage structure (billing record of requested programming; col. 7, lines 61+; col. 8, lines 35-38; col. 10, lines 43-47).

6. **Any response to this action should be mailed to:**

Commissioner of Patents and Trademarks

Washington, D.C. 20231

or faxed to:

(703) 308-9051, (for formal communications intended for entry)

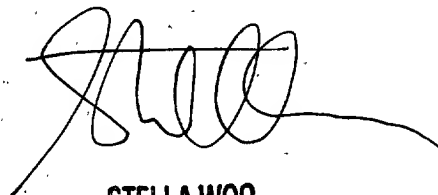
Or:

(703) 305-9508, (for informal or draft communications, please label "PROPOSED" or "DRAFT").

Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive, Arlington, VA., Sixth Floor (Receptionist).

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Stella Woo whose telephone number is (703) 305-4395 and can normally be reached Monday - Friday, 6:30 a.m. until 11:30 a.m.

July 19, 1999



**STELLA WOO
PRIMARY EXAMINER**

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